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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,068	12/06/2001	Peter M. Karas	020375-000610US	3210
20350	7590	07/05/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/010,068

Applicant(s)

KARAS ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10,12-24,26-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-24,26-28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/13/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 13 April 2006 has been entered.

### ***Response to Amendment***

The Applicant amended claims 1, 10, and 18, and canceled claims 2, 11, 25, and 29. All pending claims 1, 3-10, 12-24, 26-28, and 30 were examined in this non-final office action.

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 13 April 2006, with respect to the rejection(s) of claim(s) 1, 3-10, 12-24, 26-28, and 30 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Messner in view of Van Duesen and Walker further in view of Kolor. Kolor teaches receiving a fee from a money handler as noted below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1, 3-10, 12-24, 26-28, and 30 are rejected under 35 USC 103(a) as being unpatentable over Messner (Paper #20050527, US 6,370,514) in view of Van Dusen (Paper #20051201, US 6,175,823) and Walker (Paper #20051201, US 6,193,155), further in view of Kolor (PTO-892, Item: U).**

Messner teaches electronic email distribution of electronic gift certificates or coupons to recipients via virtual cards containing messages (please note examiner's interpretation: greeting cards). Messner further teaches:

- receiving selection of the electronic greeting card from a sender: (see at least col. 9, lines 1-17).
- receiving selection of a type of electronic gift from a plurality of gift types: gift certificate for selection among a plurality of gifts or coupon for discounts from among a plurality of gifts (see at least col. 5, lines 19-30; col. 8, lines 17-19; col. 6, lines 59-67).
- receiving payment for the electronic gift from a money handler chosen by the sender: sender chooses payment method (see at least Fig. 1B, col. 8, lines 58-59).

- creating a code indicative of the electronic gift, whereby the code facilitates redemption of the electronic gift: account number with certificate delivered separately from password (see at least col. 6, lines 41-58).
- embedding the code in the electronic greeting card: certificate containing embedded code is delivered with virtual card (see at least col. 6, lines col. 9, lines 1-5).
- embedded code includes a link to the site involved with redemption of the electronic gift: (see at least col. 8, lines 17-34).
- Receiving fee: fee or interest paid to service from central account (see at least col. 12, lines 12-30).
- future time: virtual card with message sent via email to recipient on date specified by sender (see at least col. 9, lines 9-17).
- delivery address: sender provides sender email address. Inherent in Messner are the structures necessary to permit the sender to provide a recipient email address to the online service necessary for the delivery of the email to the recipients email address. For example, the service delivers the virtual card with gift certificate to the recipient via email as previously noted above.
- first identity and second identity for verification: processing recipient email address as noted above as a first identity; sender types personalized question and answer (second identity), presents question to recipient

requesting answer as second identity to validate recipient (see at least col. 6, lines 50-58; col. 9, lines 18-50).

- Plurality of gift types: gift certificate value backed by stored value fund (e.g. debit account) (see at least col. 8, lines 58-59).
- HTML: web pages, web server, HTML, and links (see at least col. 2, line 2; col. 12, lines 65-67).
- Money handlers: gift certificate issuer (e.g. brick and mortar store, virtual mall, or voucher server) (see at least col. 8, lines 58-67).
- Payment system: voucher server separate from account server (see at least Fig. 3 (38, 54); col. 7, lines 17-42).
- Computer readable medium: Inherent in Messner are the structures necessary that permit executable code to be embodied on computer readable medium.

Messner teaches all the above as noted under the 103(a) rejection and further teaches a) using electronic links by the recipient to connect with either the voucher server or a web merchant for electronic gift certificate redemption, and b) the electronic gift certificate being preferably able to electronically direct the recipient to the web page showing the product in question, but does not specifically disclose an embedded code in the gift certificate that links the recipient to redemption site. Van Dusen teaches recipients redeeming electronic gift certificate from the Amazon.com web site. Van Dusen further teaches the electronic gift certificated containing an embedded code that links the recipient to

Art Unit: 3625

a redemption site. Van Dusen further teaches eliminating the need for the recipient to manually enter the claim code as a benefit and thereby providing a more convenient redemption process (see at least abstract; col. 1, line 54 through col. 2, line 15). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Messner to embed a code that links the recipient to a redemption site as taught by Van Dusen, in order to eliminate the need for the recipient to manually enter the claim code, and thereby attract consumers to the service by providing a more convenient redemption process.

Messner teaches all the above as noted under the 103(a) rejection and teach a) certificate redemption whereby the recipient can draw against the account in the form of redemption purchases until the balance is depleted, and b) convenience for recipients, but do not disclose a money handler chosen from two criteria. Walker teaches gift certificate redemption and further teaches stored value cards and cash redemption (see at least abstract; col. 8, lines 63-64; col. 9, line 35). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Messner and Van Dusen to identify other aspects of money handling associated with gift redemption as taught by Walker, in order to provide additional consumer convenience, and thereby attract more consumers to the service.

Messner in view of Walker teach all the above as noted under the 103(a) rejection and further teaches a) using debit accounts (Messner), and b) financial

accounts or debit accounts linked to ATM cards (see at least Fig. 5; col. 7, lines 6-28), but do not specifically disclose receiving a fee from the money handler chose by the sender. Kolor teaches a new era in ATMs whereby banks are pursuing fee-generating opportunities that add value to customer relationships. Kolor teaches the use of ATMs for dispensing more than just cash including but not limited to stamps, coupons, check reorders, and full statements. Kolor teaches Zcash from EDS facilitating wire transfers. Kolor further teaches using ATM-like devices for selling airline tickets whereby the ATM machine's owner would earn about \$7.00 for the transaction (U: see at least page 4). Please note: portion of price of airline ticket paid by consumer is eventually paid to the service by the money handler. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Messner in view of Walker to receive a fee from the money handler as taught by Kolor, in order for the service to generate income and sustain operation.

*Pertaining to claims 17-22, 28, and 30*

Rejection of claims 17-22, 28, and 30 is based on the same rationale as noted above.



### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Bank Network News; "ATMs give wire transfers a run for the money," 28 January 1998, v16i17pg4, Proquest #25876250, 3pgs; teaches Z-Cash, Wells Fargo, Western Union, and using Z-Cash in place of a birthday card whereby the gift giver writes in the confirmation code allowing the recipient to go to an ATM and get the cash (see page 3).
- Redman, Russell; "Western Union, EDS plan cash transfers via ATMs," Bank Systems & Technology, August 1998, v35i8pg19, Proquest #32279491, 3pgs; teaches Western Union, a subsidiary of First Data Corporation, licensing from EDS its patented ATM-to-ATM cash transfer system.
- US 5,650,604 (Marcous et al.) 22 July 1997; teaches ATM-to-ATM cash transfer system assigned to EDS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Fadok can be reached on 571-272-6755. The

Art Unit: 3625

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Robert M. Pond', is positioned above the printed name.

Robert M. Pond  
Primary Examiner  
June 26, 2006